

REMARKS/ARGUMENTS

No new matter has been added.

The Final Office Action mailed January 31, 2007, has been received and reviewed. Claims 1-44 are currently pending in the application. Claims 25-31, 33-34, and 37-44 have been withdrawn from consideration as being drawn to non-elected invention(s). Claims 1-24, 32, 35, and 36 stand rejected. Applicants have amended no claims, and respectfully request reconsideration of the application as presented herein.

35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on PCT Patent Publication No. WO 01/63960 to Raith

Claims 1-3, 8-11, 15-19, 23, 32, 35, and 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Raith (PCT Patent Publication No. WO 01/63960). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The 35 U.S.C. § 102(b) anticipation rejections of claims 1-3, 8-11, 15-19, 23, 32, 35, and 36 are improper because the Raith reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

The **Response to Arguments** section of the Final Office Action states:

... Applicant argues that “the Raith reference discloses a handoff technique commonly referred to as “hard handoff” wherein a mobile terminal is connected to only one base station at a time and therefore needs to drop the radio link for a brief period of time before being connected to a different, stronger transmitter. Such a handoff technique is in distinct contradiction to a “soft handoff” technique[], as claimed by Applicants, wherein a mobile terminal adds a sufficiently strong sector to active set. It is also called ... as “make before break” handoff”. (Final Office Action, p. 6, lines 12-18).

The Final Office Action in the **Response to Arguments** section then continues:

Contrary to applicant's interpretation of Raith reference, Raith clearly teaches the following: The mobile terminal tunes to the newly assigned channel during one of the idle periods so there is interruption in transmission. Thus, from the user's perspective, *the handover can be made seamless* (page 3 lines 17-20). (Final Office Action, p. 6, lines 18-21; emphasis added).

The Final Office Action in the **Response to Arguments** section then alleges:

Since *Raith clearly teaches his handoff method is seamless, th[is] clearly reads on applicants soft handoff* claimed by applicant. To further explain this, *Shi discloses* adaptive threshold of handoff in mobile telecommunication systems which teaches the following: In *a soft or "seamless" handoff* case, the mobile has two or more links with different base stations that are involved in handoff process (fig. 1, col. 1 lines 46-53). In light of this seamless handoff reads on applicant's soft handoff claimed by the applicant. Therefore rejection of claim 1 is maintained based on anticipation by Raith. (Final Office Action, p.6, line 21-p. 7, line 8; emphasis added).

The allegation that the Raith reference's use of the adjective "seamless" is synonymous with "soft handoff" may have merit if the term "seamless" was a term of art and not just a gratuitous modifier. The Raith reference's use of the term "seamless" is consistent with the dictionary definition, namely, "1: having no seams; 2: having no awkward transitions, interruptions, or indications of disparity." (<http://m-w.com/dictionary/seamless>). Specifically, there is no reason why the handoffs, namely "hard handoffs", as disclosed in the Raith reference would need to have "awkward transitions" or "interruptions" as is consistent with the plain meaning of the Raith reference's use of the term "seamless."

The Raith reference only recites the term "seamless" in the single citation identified above and therefore has not provided any further definition other than what the plain meaning of the term "fairly teaches or suggests". Accordingly, the Raith reference's use of the adjective modifier "seamless" does not fairly teach or suggest "soft handoffs" as alleged in the Final Office Action. Furthermore, the Final Office Action concedes that the Raith reference does not disclose "soft handoffs." The Final Office Action specifically states:

Raith ... teaches that handover can be made seamless ..., he does not explicitly describe this as soft handoff. (Final Office Action, p. 5, lines 17-19; emphasis added).

Regarding the Shi reference's only use of the term "seamless", the Shi reference also

includes a single recitation of the term “seamless” identified above. While the Shi reference itself may have redefined the term “seamless handoff” to be synonymous with “soft handoff”, it is improper to import a specially defined term from one reference into another reference. In support thereof, the Shi reference clearly is redefining “seamless handoff” to be synonymous with “soft handoff” since the Shi reference places the term “seamless” in quotations. However, it is clearly improper to substitute a specifically defined term from one reference in place of a term that is used according to its plain meaning in another reference.

Regarding the Final Office Action’s statement that:

... Raith clearly teaches the following: ***The mobile terminal tunes to the newly assigned channel during one of the idle periods so there is interruption in transmission.*** ... (page 3 lines 17-20). (Final Office Action, p. 6, lines 18-20; emphasis added),

the Raith reference’s citation in totality specifically discloses:

From the list of available channels, the mobile communication network selects the cell which can best serve the mobile terminal and minimize interference. A suitable traffic channel in that cell is assigned as the target, and ***the mobile terminal is commanded to retune to the traffic channel in the target cell. At the same time, the call is switched*** by the MSC from the base station currently serving the mobile terminal to the base station in the target cell. ***The mobile terminal [re]tunes*** to the newly assigned channel ***during*** one of the ***idle periods*** so there is no interruption in transmission. Thus, from the user’s perspective, the handover can be made seamless. (Raith, p. 3, lines 11-20; emphasis added).

Clearly the Raith reference discloses simultaneous switching from one base station to another, and it is known that such simultaneous switching (not to be confused with concurrent links to multiple base stations consistent with a soft handoff technique) from one base station to another is consistent with a “hard handoff” and not a “soft handoff” as claimed by Applicants.

Therefore, since the Raith reference does not disclose a soft handoff method, the Raith reference cannot anticipate, under 35 U.S.C. §102, Applicants’ invention as presently claimed. Accordingly, such claims are allowable over the cited prior art and Applicants respectfully request that such rejections be withdrawn.

For completeness, Applicants specifically argue each of the claims below.

Claims 1, 2-3

Applicants submit that the Raith reference does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claim 1, and claims 2-3 depending therefrom, because the Raith reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

The Final Office Action alleges:

Regarding claim 1, Raith discloses a wireless communication system comprising: a first transceiver in (12, fig. 1), a second transceiver in (12, fig. 1), a third transceiver in (20, fig. 1) in communication with the first transceiver, and a controller (not shown) configured to effectuate a soft handoff from the first transceiver to the second transceiver using a set of optimum parameters that are determined based on a current position of the third transceiver (20, fig. 1, page 3, line 1-page 4, line 4; figs. 1-2). (Final Office Action, p. 2).

Applicants respectfully disagree that the Raith reference anticipates Applicants' invention as claimed in independent claim 1 which reads:

1. A wireless communication system comprising:
a first transceiver;
a second transceiver;
a third transceiver in communication with the first transceiver; and
a ***controller configured to effectuate a soft handoff*** from the first transceiver to the second transceiver using a set of optimum parameters that are determined ***based on a current position of the third transceiver.*** (Emphasis added.)

In contrast, the Raith reference discloses a handoff technique commonly referred to as a "hard handoff" wherein a mobile terminal is connected to only one base station at a time and therefore needs to drop the radio link for a brief period of time before being connected to a different, stronger transmitter. Such a handoff technique is in distinct contrast to a "soft handoff" technique, as claimed by Applicants, wherein a mobile terminal adds a new sufficiently-strong sector to its active set. It is so called because the radio link with the previous sector(s) is not broken before a link is established with a new sector--this soft handoff is described as a "make before break" handoff. Specifically, the Raith reference discloses:

From the list of available channels, the mobile communication network selects the cell which can best serve the mobile terminal and minimize interference. A suitable traffic channel in that cell is assigned as the target, and ***the mobile terminal is commanded to retune to the traffic channel in the target cell. At the same time,***

The call is switched by the IVISC from the base station currently serving the mobile terminal to the base station in the target cell. The mobile terminal tunes to the newly assigned channel during one of the idle periods so there is no interruption in transmission. (Raith, p. 3, lines 11-19; emphasis added.)

While the Raith reference discloses “if the mobile communication network was provided with the location of the mobile terminal, the mobile communication network could use this information for a variety of purposes, such as to optimize handovers”, the handoff considerations and procedures for soft handoffs, as claimed by Applicants, and hard handoffs, as disclosed by the Raith reference, are radically different and independent. (Raith, p. 4, lines 1-4).

Clearly, the Raith reference discloses use of location data for performing hard handoffs, however, the Raith reference does not describe, either expressly or inherently, Applicants’ identical inventions in as complete detail as are contained in the claims. Specifically, the Raith reference does not describe in as complete detail “a **controller configured to effectuate a soft handoff** from the first transceiver to the second transceiver using a set of optimum parameters that are determined **based on a current position of the third transceiver**”, as claimed by Applicants in independent claim 1 from which claims 2-3 depend. Therefore, the Raith reference **cannot** anticipate, under 35 U.S.C. §102, Applicants’ invention as presently claimed.

Therefore, independent claim 1, and claims 2-3 depending therefrom, are not anticipated by the Raith reference under 35 U.S.C. § 102. Accordingly, such claims are allowable over the cited prior art and Applicants respectfully request that such rejections be withdrawn.

Claims 8-11

Applicants submit that the Raith reference does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claim 8 and claims 9-11 depending therefrom because the Raith reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

The Final Office Action alleges:

Regarding claim 8, Raith discloses a mobile unit comprising: a receiver in (20, fig. 1) configured to receive set of optimum system access parameters determined in a current position of the mobile unit (this is implied as the reference teaches using position of mobile communicat[ion] device to optimize handovers), a controller (not shown) to

effectuate a soft handoff from first base station (12, fig. 1) to a second base station (like 12, fig. 1) based on the received set of optimum soft-handoff parameters (20, fig. 1, page 3, line 1-page 4, line 4; figs. 1-2). (Final Office Action, p. 2).

Applicants respectfully disagree that the Raith reference anticipates Applicants' invention as claimed in independent claim 8 which reads:

8. A mobile unit comprising:
a ***receiver unit configured to receive*** a set of optimum ***soft-handoff parameters determined based on a current position of the mobile unit***; and
a ***controller configured to effectuate a soft handoff*** from a first base station to a second base station ***based on the*** received set of optimum ***soft-handoff parameters***. (Emphasis added.)

Applicants herein sustain the above-proffered arguments relating to the specific disclosure of the Raith reference. As stated above and in contrast to Applicants' invention as claimed, the Raith reference discloses a handoff technique commonly referred to as a "hard handoff". Such a handoff technique is in distinct contrast to a "soft handoff" technique, as claimed by Applicants.

While the Raith reference discloses "if the mobile communication network was provided with the location of the mobile terminal, the mobile communication network could use this information for a variety of purposes, such as to optimize handovers", the handoff considerations and procedures for soft handoffs, as claimed by Applicants, and hard handoffs, as disclosed by the Raith reference, are radically different and independent. (Raith, p. 4, lines 1-4).

Clearly, the Raith reference discloses use of location data for performing hard handoffs, however, the Raith reference does not describe, either expressly or inherently, Applicants' identical inventions in as complete detail as are contained in the claims. Specifically, the Raith reference does not describe in as complete detail "a ***receiver unit configured to receive*** a set of optimum ***soft-handoff parameters determined based on a current position of the mobile unit***, and a ***controller configured to effectuate a soft handoff*** from a first base station to a second base station ***based on the*** received set of optimum ***soft-handoff parameters***", as claimed by Applicants in independent claim 8 from which claims 9-11 depend. Therefore, the Raith reference **cannot** anticipate, under 35 U.S.C. §102, Applicants' invention as presently claimed.

Therefore, independent claim 8 and claims 9-11 depending therefrom are not anticipated by the Raith reference under 35 U.S.C. § 102. Accordingly, such claims are allowable over the cited prior art and Applicants respectfully request that such rejections be withdrawn.

Claims 15-19

Applicants submit that the Raith reference does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claim 15 and claims 16-19 depending therefrom because the Raith reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

The Final Office Action alleges:

Regarding claim 15, Raith discloses a base station comprising: a transmitter unit in (12, fig. 1) configured to transmit to the mobile unit (20, fig. 1) a set of optimum soft-handoff parameters determined based on a current position of the mobile unit in first coverage area (fig. 1) and a controller in (12, fig. 2) configured to effectuate a soft handoff from the first coverage area to a second coverage area based on the set of optimum soft-handoff parameters (page 7 lines 19-24; page 3 lines 3-20; page 8, lines 2-4, lines 14-15; page 9 lines 1-21). (Final Office Action, p. 3).

Applicants respectfully disagree that the Raith reference anticipates Applicants' invention as claimed in independent claim 15 which reads:

15. A base station comprising:
a ***transmitter unit configured to transmit*** to the mobile unit a set of optimum ***soft-handoff parameters determined based on a current position of the mobile unit*** in a first coverage area; and
a ***controller configured to effectuate a soft handoff*** from the first coverage area to a second coverage area ***based on the*** set of optimum ***soft-handoff parameters***. (Emphasis added.)

Applicants herein sustain the above-proffered arguments relating to the specific disclosure of the Raith reference. As stated above and in contrast to Applicants' invention as claimed, the Raith reference discloses a handoff technique commonly referred to as a "hard handoff". Such a handoff technique is in distinct contrast to a "soft handoff" technique, as claimed by Applicants.

While the Raith reference discloses "if the mobile communication network was provided

with the location of the mobile terminal, the mobile communication network could use this information for a variety of purposes, such as to optimize handovers”, the handoff considerations and procedures for soft handoffs, as claimed by Applicants, and hard handoffs, as disclosed by the Raith reference, are radically different and independent. (Raith, p. 4, lines 1-4).

Clearly, the Raith reference discloses use of location data for performing hard handoffs, however, the Raith reference does not describe, either expressly or inherently, Applicants’ identical inventions in as complete detail as are contained in the claims. Specifically, the Raith reference does not describe in as complete detail “a *transmitter unit configured to transmit to the mobile unit a set of optimum soft-handoff parameters determined based on a current position of the mobile unit* in a first coverage area; and a *controller configured to effectuate a soft handoff* from the first coverage area to a second coverage area *based on the set of optimum soft-handoff parameters*”, as claimed by Applicants in independent claim 15 from which claims 16-19 depend. Therefore, the Raith reference cannot anticipate, under 35 U.S.C. § 102, Applicants’ invention as presently claimed.

Therefore, independent claim 15 and claims 16-19 depending therefrom are not anticipated by the Raith reference under 35 U.S.C. § 102. Accordingly, such claims are allowable over the cited prior art and Applicants respectfully request that such rejections be withdrawn.

Claim 23

Applicants submit that the Raith reference does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claim 23 because the Raith reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claim.

The Final Office Action alleges:

Regarding claim 23, Raith discloses a method for effecting soft handoff, comprising: determining a set of optimum parameters based on the current position of the mobile unit (20, fig. 1), and effectuating a soft handoff from the first coverage area to a second coverage area (see fig. 1) using a set of optimum parameters (page 3, line 7-page 4, line 4; figs 1-2). (Final Office Action, p. 3).

Applicants respectfully disagree that the Raith reference anticipates Applicants’

invention as claimed in independent claim 23 which reads:

23. A method for effectuating soft handoff, comprising:
determining a current position of a mobile unit in a first coverage area;
determining a set of optimum parameters based on the current position of the mobile unit; and
effectuating a soft handoff from the first coverage area to a second coverage area ***using the set of optimum parameters.*** (Emphasis added.)

Applicants herein sustain the above-proffered arguments relating to the specific disclosure of the Raith reference. As stated above and in contrast to Applicants' invention as claimed, the Raith reference discloses a handoff technique commonly referred to as a "hard handoff". Such a handoff technique is in distinct contrast to a "soft handoff" technique, as claimed by Applicants.

While the Raith reference discloses "if the mobile communication network was provided with the location of the mobile terminal, the mobile communication network could use this information for a variety of purposes, such as to optimize handovers", the handoff considerations and procedures for soft handoffs, as claimed by Applicants, and hard handoffs, as disclosed by the Raith reference, are radically different and independent. (Raith, p. 4, lines 1-4).

Clearly, the Raith reference discloses use of location data for performing hard handoffs, however, the Raith reference does not describe, either expressly or inherently, Applicants' identical inventions in as complete detail as are contained in the claims. Specifically, the Raith reference does not describe in as complete detail "***determining a set of optimum parameters based on the current position of the mobile unit; and effectuating a soft handoff*** from the first coverage area to a second coverage area ***using the set of optimum parameters***", as claimed by Applicants in independent claim 23. Therefore, the Raith reference **cannot** anticipate, under 35 U.S.C. §102, Applicants' invention as presently claimed.

Therefore, independent claim 23 is not anticipated by the Raith reference under 35 U.S.C. § 102. Accordingly, such claim is allowable over the cited prior art and Applicants respectfully request that such rejection be withdrawn.

Claims 32, 35, 36

Applicants submit that the Raith reference does not and cannot anticipate under 35

U.S.C. § 102 the presently claimed invention of independent claims 32, 35 and 36 because the Raith reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

The Final Office Action alleges:

Regarding claims 32, 35, 36, Raith discloses a computer readable medium embodying a method for effectuating soft handoff, the method comprising: determining optimum parameters based on the current position of the mobile unit (20, fig. 1), and effectuating a soft handoff from the first coverage area to a second coverage area using the set of optimum parameters (page 3, line 7-page 4, line 4; figs 1-2), a memory unit in (26, fig. 2) and a digital signal processing (DSP) unit communicatively coupled to the memory unit, the DSP (reads on GPS 50, fig. 2) being capable of determining a current position of mobile unit in a first coverage area (page 9 lines 1-8). (Final Office Action, p. 3).

Applicants respectfully disagree that the Raith reference anticipates Applicants' invention as claimed in independent claims 32, 35 and 36 which read:

32. A computer readable medium embodying a method for effectuating soft handoff, the method comprising: determining a current position of a mobile unit in a first coverage area; **determining** a set of optimum **parameters based on the current position of the mobile unit**; and **effectuating a soft handoff** from the first coverage area to a second coverage area **using the** set of optimum **parameters**. (Emphasis added.)

35. An apparatus for effectuating soft handoff, comprising: means for determining a current position of a mobile unit in a first coverage area; means for **determining** a set of optimum **parameters based on the current position of the mobile unit**; and means for **effectuating a soft handoff** from the first coverage area to a second coverage area **using the** set of optimum **parameters**. (Emphasis added.)

36. An apparatus for effectuating soft handoff, comprising: a memory unit; and a digital signal processing (DSP) unit communicatively coupled to the memory unit, the DSP being capable of: determining a current position of a mobile unit in a first coverage area; **determining** a set of optimum **parameters based on the current position of the mobile unit**; and **effectuating a soft handoff** from the first coverage area to a second coverage area **using the** set of optimum **parameters**. (Emphasis added.)

Applicants herein sustain the above-proffered arguments relating to the specific disclosure of the Raith reference. As stated above and in contrast to Applicants' invention as claimed, the Raith reference discloses a handoff technique commonly referred to as a "hard

handoff”. Such a handoff technique is in distinct contrast to a “soft handoff” technique, as claimed by Applicants.

While the Raith reference discloses “if the mobile communication network was provided with the location of the mobile terminal, the mobile communication network could use this information for a variety of purposes, such as to optimize handovers”, the handoff considerations and procedures for soft handoffs, as claimed by Applicants, and hard handoffs, as disclosed by the Raith reference, are radically different and independent. (Raith, p. 4, lines 1-4).

Clearly, the Raith reference discloses use of location data for performing hard handoffs, however, the Raith reference does not describe, either expressly or inherently, Applicants’ identical inventions in as complete detail as are contained in the claims. Specifically, the Raith reference does not describe in as complete detail “[] *determining* a set of optimum *parameters based on the current position of the mobile unit*, and [] *effectuating a soft handoff* from the first coverage area to a second coverage area *using the* set of optimum *parameters*”, as claimed by Applicants in independent claims 32, 35 and 36. Therefore, the Raith reference **cannot** anticipate, under 35 U.S.C. §102, Applicants’ invention as presently claimed.

Therefore, independent claims 32, 35 and 36 are not anticipated by the Raith reference under 35 U.S.C. § 102. Accordingly, such claims are allowable over the cited prior art and Applicants respectfully request that such rejections be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on PCT Patent Publication No. WO 01/63960 to Raith in View of U.S. Patent No. 6,594,243 to Huang et al.

Claims 4-6, 12, 13, 19-22, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Raith (PCT Patent Publication No. WO 01/63960) in view of Huang et al. (U.S. Patent No. 6,594,243). Applicants respectfully traverse this rejection, as hereinafter set forth.

The nonobviousness of independent claim 1 precludes a rejection of claims 4-6 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. §

103 rejection to claims 4-6 depending from nonobvious independent claim 1.

The nonobviousness of independent claim 8 precludes a rejection of claims 12-13 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103 rejection to claims 12-13 depending from nonobvious independent claim 8.

The nonobviousness of independent claim 15 precludes a rejection of claims 19-22 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103 rejection to claims 19-22 depending from nonobvious independent claim 15.

The nonobviousness of independent claim 23 precludes a rejection of claim 24 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103 rejection to claims 24 depending from nonobvious independent claim 23.

Obviousness Rejection Based on PCT Patent Publication No. WO 01/63960 to Raith in View of U.S. Patent No. 6,507,740 to Shi

Claims 7 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Raith (PCT Patent Publication No. WO 01/63960) in view of Shi (U.S. Patent No. 6,507,740). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. **First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success.** Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.** *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 7 and 14 are improper because the elements for a prima facie case of obviousness are not met. Specifically, the rejection fails to meet the criterion that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art and the teaching or suggestion must be found in the prior art and not based on applicant's disclosure.

The Final Office Action alleges:

Regarding claim 7, Raith discloses a mobile unit comprising: a receiver in (12, fig. 1) configured to receive set of optimum system access parameters determined on a current position of the mobile unit (this is implied as the reference teaches using position of mobile communicat[ion] device to optimize handovers), a controller (not shown) configured to control mobile unit based on the received set of optimum system access-parameters (20, fig. 1, page 3, line 1-page 4, line 4; figs. 1-2).

Regarding claim 14, Raith discloses a base station comprising: a transmitter unit (12, fig. 1) configured to transmit set of optimum system-access parameters determined based on the current position of mobile unit (20, fig. 1), and a controller in (12, fig. 1) configured to control the mobile unit based on the set of optimum system access parameters (page 7 lines 19-24; page 3 lines 3-20; page 8, lines 2-4, lines 14-15; page 9 lines 1-21).

Raith differs from claim 7 and 14 in that although he teaches that handover can be made seamless (which reads on effecting soft handoff: page 3 lines 19-20), he does not explicitly describe this as soft handoff.

However, Shi discloses adaptive threshold of handoff in mobile telecommunication system which teaches the following: in a soft or "seamless" handoff case, the mobile has two or more links with different base station that are involved in handoff process (fig. 1, col. 1 lines 46-53). (Final Office Action, p. 5).

The Examiner is respectfully reminded that there must be a **basis in the art for combining or modifying references**. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (holding that "although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."). Additionally, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teaching of the prior art so that the claimed invention is rendered obvious One

cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fritch, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Applicants assert that not only does the Raith reference teach or suggest hard handoffs, the Raith reference is built entirely around the concept of the switching capabilities based on geographic location and would have no need to employ a handoff technique that would further burden base stations by maintaining concurrent channels with multiple base stations. Clearly, the Raith reference does not appear to suggest the desirability of further burdening base stations to maintain additional links as is common to soft handoffs. Thus, neither the Raith reference, nor the Shi reference suggest the desirability of combining a soft handoff into a geographically based hard handoff system to arrive at the present invention.

Applicants also respectfully remind the Examiner that a "prima facie case of obviousness may be rebutted by showing that the art, in any material respect, **teaches away from the claimed invention.**" In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Furthermore, it "is improper to combine references where the references teach away from their combination." M.P.E.P. §2145(X)(D)(2) (citing In re Grasselli, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)). Similarly, if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. §2143.01 (citing In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

Applicants assert that the Raith reference actually teaches away from a soft handoff. The Raith reference teaches or suggests "if the mobile communication network was provided with the location of the mobile terminal, the mobile communication network could use this information for a variety of purposes, such as to optimize handovers". Therefore, the location data of the Raith reference provides a mechanism for enhancing the existing hard handoffs without burdening the channel capacity of the system by maintaining concurrent links with multiple base stations as required by soft handoff techniques. (Raith, p. 4, lines 1-4).

For these reasons, Applicants assert that a 35 U.S.C. § 103 rejection of claims 7 and 14 based on the Raith reference in combination with the Shi reference, is improper and respectfully request that the rejection of claims 7 and 14 be withdrawn.

ENTRY OF RESPONSE

The proposed remarks to the claims above should be entered by the Examiner because the remarks are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the remarks do not raise new issues or require a further search. Finally, if the Examiner determines that the remarks do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1-24, 32, 35 and 36 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

Dated: March 21, 2007

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